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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,982

03/28/2005

Akira Kakizura

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7590

05/22/2006

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EXAMINER

SINGH, ANOOP KUMAR

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,982	<b>Applicant(s)</b> KAKIZURA ET AL.	
	<b>Examiner</b> Anoop Singh	<b>Art Unit</b> 1632	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

***Election/Restrictions***

1. Claims 1-3 are pending.
2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-2, drawn to a drug for obesity and/or diabetes and a method of screening a substance that serves as the ingredient in a drug for obesity and/or diabetes comprising treating the cells or an animal with a candidate substance.

Group II, claim(s) 3, drawn to a transgenic non human animal having a purified polynucleotide encoding a ligand factor ERRL1 for a nuclear receptor ERR in its genomic DNA and over expressing the ligand factor ERRL1.

3. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-II is a method for screening a drug for obesity and/or diabetes. Ohara et al (WO 00/26365, dated 05/11/2000, IDS) teach a protein ERR $\gamma$  that could be used as drug or developing drugs (abstract). Therefore, the instant technical feature does not contribute over prior art.

In addition, the inventions are distinct, each from other because of the following reasons: Inventions I-II are unrelated. Inventions are unrelated if it can be shown that

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they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the compositions of the group II is patentably distinct from the methods of group I because method cannot be used to produce the compositions. Alternatively, the compositions will be used in more than one method. In the instant case nonhuman transgenic comprising a polynucleotide encoding a ligand factor ERRL1 can be used in a disease model or drug screening which is distinct and different from the method steps involve in screening a drug for obesity by determining transcriptional activity of ERR or increased binding of ERRL1 to ERR. Each of these involves distinct and different method steps and composition and therefore, searching for distinct method steps and composition will not be coextensive and will require separate and independent searches in the patent and non-patent literature.

Each invention is directed to distinct goal, which comprises the use nonhuman transgenic or candidate substance for obesity/diabetes in order to achieve its respective and intended objective. Thus, it follows from the preceding analysis that the claimed inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the reasons set forth above.

4. A search and examination of more than one invention as defined above would unduly burden the office. Each of the inventions requires a different search of the art and concerns separate considerations of patentability. For example, the subject matter

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of many of the subject matter of many of the inventions is not largely co-extensive as the inventions are related to distinct method and compositions. Therefore, restriction as defined above is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anoop Singh whose telephone number is (571) 272-3306. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272- 0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anoop Singh, Ph.D.  
Examiner, AU 1632

*Joe Winters*  
*AU 1632*